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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of: Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features

29/Depn
8/28/00
Petition
1.181
RECEIVED

JUN 20 2000

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Assistant Commissioner for Patents

Attn: Group Director

Washington, D.C. 20231

Dear Director:

PETITION TO INVOKE SUPERVISORY AUTHORITY OF THE COMMISSIONER
UNDER 37 C.F.R. § 1.181

In re ex parte prosecution of the above-identified patent application, Applicant respectfully petitions the commissioner to invoke supervisory authority of the commissioner.

Certificate of Mailing / Transmission Under 37 C.F.R. 1.8(a), 1.10

I hereby certify that, on the day shown below, this correspondence is being:

Deposited with the United Postal Service in an envelope addressed to : Commissioner of Patents and Trademarks, Washington, D.C. 20231,

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Signature

Date: 06/13/00

Shalong Maa
(Type or print name of person certifying)

1. Applicant has previously filed Petition on 10/27/99 under 37 C.F.R. § 1.181, concurrently with Applicant's Response to the Office Action of 08/02/99, to invoke supervisory authority of the Commissioner. The previous Petition was taken from excessive errors and unresponsiveness to Applicant's argument in the Office Action dated 08/02/99, and from communication problems Applicant had during the prosecution. The petition was dismissed by the Group Director for untimely filing and lack of repeated action by the examiner. Applicant respectfully accepted Group Director's decision, as so stated in Applicant's communication submitted 01/10/00.
2. Applicant respectfully points out that, the second Office Action dated 05/15/00 is still unresponsive to Applicant's many important points of argument and citation of authorities, as described in detail hereinbelow, although the Office Action does provide substantial discussion of certain issues raised by Applicant. In addition, Applicant received the Office Action of 05/15/00 more than six and half (6.5) months after Applicant's Response filed 10/27/99. Thus, the present Petition is also taken from the Office's withholding of the application proceeding.

STATEMENT OF FACTS

3. Withholding of the Proceeding

As described above, the second Office Action dated 05/15/00 was sent to Applicant more than six and half (6.5) months after Applicant's Response filed 10/27/99 without written statement of cause of the delay. Applicant had made several attempts to obtain status information of the application from the Office, including postal-mails and facsimile communication, without any written reply thereto. Applicant also had two telephone conversations with the Examiner during which Applicant was informed that the second Office Action was forthcoming. However, Applicant was not able to receive the second Office Action until after tele-conference with the Group Director, Ms. E. Rollins-Cross, in person on 05/09/00.

4. Unresponsive Office Action / Illogical Argument

4.1. Applicant has vehemently requested that Examiner answer all materials traversed and provide full response to Applicant's each argument point, as so stated in Applicant's previous Response filed 10/27/99 as: "Examiner has[ve] ignored and is unresponsive to almost all points of arguments in the REMARKS [Applicant's previous communication filed 07/04/99] ... Applicant respectfully requests, and insists, that Examiner explicitly addresses (either agree or point out the exact portion that he/she is opposed to), in the ensuing Office Action, each and every point of argument herein and in the REMARKS"

4.2 However, the next Office Action dated 05/15/00 is still unresponsive to Applicant's many important points of argument and citation of authorities, although the Office Action does provide substantial discussion of certain issues raised by Applicant. In some cases, Applicant has difficulties in understanding the rationale of Examiner's argument and response. For example, with respect to Applicant's communication filed 10/27/99:

(a) (i). The Office Action of 05/15/00 fails to respond to, (1) discussions of "Non-analogous Art" in subsection 4.2 on page 4, (2) citation of authority in subsection 4.1 on page 4 in support of the "Non-analogous Art" argument, and (3) discussions and citation of authority in subsection 4.3 on page 5 in support of the "Non-analogous Art" argument.

(ii). Note that, the Office Action does provide very brief response to Applicant's request in subsection 4.4 on page 5. 170

(b) (i). The Office Action of 05/15/00 fails to respond to, (4) discussions of "Different Structures and Functions" in subsection 5.1 on page 5, in Applicant's Response filed 10/27/99.

(ii). Note that, in response to Applicant's argument in subsection 5.3 on page 5, the Office Actions of 05/15/00 states in section 18 (page 12-13), that "... *Applicant's argument fail to comply with 37CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references*".

(iii). On the contrary, subsection 5.1 of Applicant's 10/27/99 Response does specifically point out how the claim languages patentably distinguish them from the references, and refers to the REMARKS portion of Applicant's communication of 07/04/99 which also points out how the claim languages patentably distinguishes them from the references (e.g., in section 4, subsections 5.2-3, subsections 5.4-6, and at end of section 7 of the REMARKS). There is no response to these discussions in any of the two Office Actions.

(c) (i). The Office Action of 05/15/00 fails to respond to, (5) citation and discussion of authority in subsection 6.1 on page 5 in support of the argument under "Claim Limitation Not Being Taught or Suggested in Prior Art", in Applicant's Response filed 10/27/99.

(ii). Note that, in response to Applicant's argument in subsection 6.3 on page 6, the Office Action states in section 19 on page 13 that "*Applicant's argument fail to comply with 37CFR 1.111(b) because they amount to a general allegation that claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references*".

(iii). However, the entire claim languages of Claims 35-36 are drawn to the

IMPROVEMENT of the present invention compared with prior art inventions, and specifically set forth the claim elements that patentably distinguish the claimed invention from the references. Thus, again, Applicant respectfully represents that it is very difficult to understand the rationale of the Examiner's argument.

(d) (i). The Office Action of 05/15/00 fails to respond to, (6) discussions of “Proposed Modification Not Feasible[ility]” in subsections 7.1-3 on page 6, in Applicant’s Response filed 10/27/99.

(ii). Note that, In response to Applicant’s argument in subsection 7.4 on page 6, the Office Action of 05/15/00 states, on page 14 (section 20), that “... *since Applicant has not given any reason why such a modification is not feasible, the argument amounts to a general allegation*”

(iii). On the contrary, Applicant does specifically point out, in the very same section, why the alleged modification of the reference be functionally unfeasible, and refers to Applicant’s previous communication of 07/04/99 which also provides technical arguments regarding the alleged modification of the reference being functionally unfeasible. There is no response to these discussions in any of the two Office Actions. Thus, again, Applicant respectfully represents that it is very difficult to understand the rationale and good faith of Examiner’s argument.

(e) The Office Action of 05/15/00 fails to respond to, (7) citation of authority in subsection 9.1 on page 7 in support of the discussion of “Subject Matter as a Whole”, in Applicant’s Response filed 10/27/99.

(f) The Office Action of 05/15/00 fails to respond to, (8) discussions of “modification needs to be substantial” in subsection 10.1 on page 7-8, in Applicant’s Response filed 10/27/99.

5. Interpretation of Statutes Applied

5.1 Applicant acknowledges that majority of the arguments in the Office Actions dated 08/02/99 and 05/15/00 in support of the obviousness Rejections therein are mere statement of Examiner’s personal opinion with respect to obviousness of a specific device (i.e., solenoid) employed in the claimed invention, without source of supporting rationale.

5.2 In regarding applying authorities such as MPEP and prior case law in interpretation of the statutes applied in Rejections and lack thereof in the 08/02/99 Office Action, Applicant’s Response of 10/27/99 states that “Applicant has provided Legal Precedent in support [of] the arguments herein, and respectfully request that Examiner do the same should he/she is [be] opposed to any of said arguments.” and “ ‘The value of the exceedingly large body of precedent wherein our predecessor courts and this court have applied the law of obviousness to particular facts, is that there has been built a wide spectrum of illustrations

and accompanying reasoning, that have been melded into a fairly consistent application of law to a great variety of facts.' In re Eli Lilly & Co., 902 F.d. 943, 14 USPQ2d 1741 (Fed. Cir. 1990)" (See also MPEP§ 2144)

5.3 Apparently, the next Office Action of 05/15/00 fails to respond to these requests. As described above, Applicant again does not find any suitable citation or discussion of MPEP, legal precedent or other authorities as basis for interpretation of the statutes applied in the Rejections in response to Applicant's argument, and there is no discussion as to why Applicant's citations of authorities do not provide sufficient support of Applicant's traverses, although all Claims have been rejected.

5.4 (a). The 05/15/00 Office Action does refer to "*In re Fine*" and "*In re Jones*" in section 23 on page 16 in supporting the obviousness rejections therein, which are the only two cases referred to in the Office Actions. Applicant acknowledges that discussions of the court decisions in *In re Fine* and *In re Jones* are also provided in MPEP §2143.01, which states that "In *In re Fine*, The examiner and Board asserted that it would have been within the skill of the art to ..., however the court found there was no support or explanation of this conclusion and reversed." and "*In re Jones*, ... The court found there was no suggestion to combine these references to arrive at the claimed invention."

(b). Thus, it appears that the rationale used by the court in both two cases are in support of Applicant's traverses instead of Examiner's ground of Rejections. Thus, again, Applicant has difficulties in understanding the rationale of the argument in the Office Action and Examiner's good faith.

5.5 (a). The 05/15/00 Office Action states, on page 10 (under section 14), that "*where an explanation or argument is being maintained from one Office Action to the next, it is appropriate to 'cut and paste' from the first to the second action in order to avoid unnecessary or confusing changes in wording ...*"

(b). However, Applicant acknowledges that the Office Action of 05/15/00 includes a new statutory basis as ground of rejecting claims, i.e., anticipation Rejections under 35 U.S.C.§ 102(e), and the entire arguments in support thereof (section 4 / page 3) is "cut and paste" from Section 4 (page 3-4) of the Office Action dated 11/10/98, which were provided in support of Rejections under a different statutory basis, i.e., obviousness Rejections under 35 U.S.C.§103(a).

POINTS TO BE REVIEWED

6. Applicant respectfully requests that the Group Direct review the foregoing facts and Applicant's, as well as the Examiner's, bona fide attempt to properly advance the application proceeding in good faith.

ACTIONS REQUIRED

7. Proper Advancement of the Proceeding

7.1 Applicant respectfully represents that proper advancement of the examination proceeding in its regular turn by the Office is vital to Applicant's interests. Applicant has filed Appeal from the Examiner's decision of rejecting Claims to the Board of Patent Appeals and Interference, and is specially concerned with proper advancement of the appeal proceeding.

7.2 Since there has been withholding of the application proceeding by the Office without written statement of cause thereof, as described hereinabove, Applicant hereby respectfully requests proper advancement of the examination and appeal proceedings and that the Group Director supervise the advancement.

8. Answer All Material Traversed

8.1 In Applicant's Response filed 10/27/99, Applicant has vehemently requested that Examiner answer all materials traversed. Applicant believes that such request complies with Office rules, practice, and procedure. However, as described above, the second Office Action dated 05/15/00 still fails to respond to Applicant's many important argument points.

8.2 Applicant has repeated such request of answering all material traversed in the previous Petition and in the recently filed Appeal Brief, and would like to repeat the request herein again as follows:

Each argument section / subsection of the recently submitted Appeal Brief is carefully labeled in numerical and/or alphabetic order for the convenience of the Examiner; Applicant respectfully requests that the ensuing Examiner's Answer or Action provide precise and full response to Applicant's each point of argument therein, i.e., either provide brief statement of agreement therewith, or point out the exact portion that Examiner is opposed to, and state why Applicant's each citation of authority or applying legal precedent does not provide sufficient support of Applicant's traverse if so regarded by the Examiner; Applicant respectfully represents that lack of response to Applicant's any argument point would be construed as Examiner's agreement therewith.

9. Interpretation of Statutes Applied

9.1 In Applicant's Response filed 10/27/99, Applicant has requested that Examiner follow *Graham v. John Deere Co.* in consideration and determination of obviousness of the claimed invention under 35 U.S.C. 103, as required by MPEP § 2141, and that Examiner provides suitable discussion of prior case law or citation of authority in support of the Rejections. Apparently, as described above, these requests have been disregarded by the Examiner.

S.M.



9.2 Applicant has, in the recently filed ~~Appeal Brief~~, repeated such request of relying on authorities in obviousness rejections, and would like to repeat the request herein again as follows:

Applicant has provided sufficient citations of authorities and/or discussions of prior case law in recently filed Appeal Brief in support of Applicant's traverses and argument. Applicant respectfully requests that Examiner do the same in the ensuing Examiner's Answer or Action in support of its argument and in interpretation of statutes applied in Rejections, and state therein why Applicant's each citation of authority or reference to prior case law or rationale used by the court does not provide sufficient support of Applicant's traverse if so regarded by the Examiner.

CONCLUSION

For the foregoing reasons, Applicant respectfully petitions the commissioner to invoke supervisory authority of the commissioner Under 37 C.F.R. § 1.181.

Respectfully submitted,

By: 

Shalony Maa
(Print name of person signing)

Date: 06/12/00

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